

a] said tool shank including a first tool recess formed within a first tool-supporting region located on one side of a tool-supporting end of the shank, and a second tool recess formed within a second tool-supporting region located opposite the first tool-supporting region, wherein each tool recess is defined by a first tool-supporting surface and a second tool supporting surface spaced apart from, and oriented at an acute angle relative to the respective first tool-supporting surface, and each tool recess is adapted to receive and support a respective tool insert between its first and second tool-supporting surfaces; and wherein each tool-supporting region further includes an elongated body portion formed between the respective second tool-supporting surface and an adjacent side of the tool-supporting end of the shank, and each elongated body portion defines a maximum width of at least approximately 1.0 mm; and wherein the maximum width of each tool-supporting region of the shank extending between an outer end of the respective first tool-supporting surface and the opposite side of the respective elongated body portion is less than approximately 9 mm.

Please add the following new claim:

17. (New) A tool insert as defined in claim 12, wherein the two sides of the insert extend transversely outwardly from the shank relative to an axis of the shank.

Remarks

Claims 3 and 12 have been amended, new claim 17 has been added, and therefore claims 1-17 are pending in this application. In view of the following remarks, it is respectfully submitted that these claims are allowable.

Claims 1-11 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 16-19 and 1-7 of prior U.S. Patent No. 5,779,400, i.e., a "statutory" double patenting rejection. The Examiner's grounds for rejection are hereinafter traversed, and reconsideration is respectfully requested.

A statutory double patenting rejection applies only where the "same" invention is claimed in both the application and the patent. M.P.E.P. § 804. "Same invention" means identical subject matter. Id.; Miller v. Eagle Mfg. Co., 151 U.S. 186 (1984) and In re Vogel, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970). Thus, one test for determining double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without infringing a corresponding claim in the patent. In re Vogel, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970).

Here, claims 1-11 of this application do not claim the identical subject matter as that of claims 16-19 and 1-7 of Applicant's '400 patent. To the contrary, independent claim 1 of the present application could be literally infringed without literally infringing the corresponding independent claims (1 and 16) of the '400 patent. For example, independent claim 1 of this application literally covers the tool insert employed in the embodiments of FIGS. 8-12 of this application. Independent claims 1 and 16 of the '400 patent, on the other hand, do not literally cover these embodiments. Accordingly, it is respectfully submitted that the statutory double patenting rejection should be withdrawn for at least these reasons.

The allowance of claims 12-16 is gratefully acknowledged. Accordingly, claim 12 has been rewritten in independent form to include all of the limitations of independent claim 1.

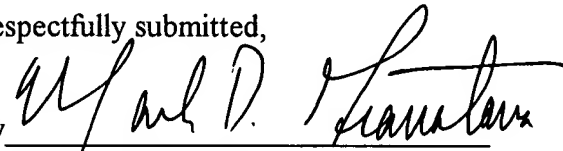
It is therefore respectfully submitted that claims 1-17 are allowable, and an early action to that effect is earnestly solicited. No fee in addition to that already submitted herewith is believed

to be required; however, if a fee is required, or otherwise if necessary to cover any deficiency in fees already paid, authorization is hereby given to charge our deposit account no. 11-0231.

Respectfully submitted,

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By



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